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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CELIA R. DUKE-MORAN
and SCOTT R. WEINER

Appeal No. 97-0628
Application 07/992,428¹

ON BRIEF

Before KRASS, JERRY SMITH and LEE, Administrative Patent Judges.
LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 6-10, 12-20 and 30.

No claim has been allowed.

Application for patent filed December 17, 1992.

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References Relied on by the Examiner

Reed et al. (Reed)	5,241,671	Aug. 31, 1993
Biles	5,369,763	Nov. 29, 1994 (filed May 26, 1992)
Kucera et al. (Kucera)	4,868,750	Sep. 19, 1989
Chang et al. (Chang)	5,321,833	June 14, 1994 (filed August 29, 1990)
Morita	5,297,042	March 22, 1994 (filed October 5, 1990)
Miyamoto et al. (Miyamoto)	4,943,933	July 24, 1990
Hung et al. (Hung)	5,325,465	June 29, 1994 (filed March 4, 1992)

The Rejection on Appeal

Claims 6, 7, 9, 10, 12, 13, 16-20 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Reed in view of either Chang or Morita, and Biles and Kucera.

Claims 8, 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Reed in view of either Chang or Morita, and Biles and Kucera, and further in view of either Miyamoto or Hung.

The Invention

The invention is directed to a method for searching media articles for reviewing the information content thereof and then categorizing the subject matter according to predetermined

topics. First, a series of topics under which the articles are classified is listed and a chosen article is stored in a data base. Then, a series of keywords, selected according to desired information, is generated. The keywords are associated with at least one predetermined topic and a tag is assigned to the associated topic and keyword to form a tagged word. A weighing factor is assigned to the tag. A score is provided which indicates the keywords present in the article in relation to the weighing factor and the tag. The articles having the greatest score for the predetermined topic are selected.

Claims 6, 12 and 13 are independent claims. Claim 6 further requires that the topics list includes age level information for individuals. Claim 12 further requires that the topics list includes focus information regarding handicapped individuals such as those who are deaf, blind, emotionally disturbed, having learning disability, mentally retarded, orthopedically or visually handicapped. Claim 13 further requires that the topics list includes topics selected from the group of handicapped persons, accessibility to buildings, transportation, advertising, performing arts, education, medical treatment, counseling, sports, rehabilitation, technology, welfare, AIDS and taxes.

Representative claim 6 is reproduced below:

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6. A method of searching media articles particularly newspaper articles for reviewing the information content in said article and for categorizing the subject matter according to predetermined topics, comprising the steps of:

listing a series of topics under which said articles are classified according to desired information content, wherein said listing further includes age level information for individuals,

storing said articles in a database,

generating a series of keywords selected according to desired information,

associating said keywords with at least one said predetermined topic and assigning a tag to the associated topic and keyword to form a tagged word,

attaching a weighting factor to each generated said tag,

providing a score indicating keywords present in said article in relation to said weighting factor and said tag,

selecting those articles having the greatest score as related to said predetermined topic.

Opinion

The rejection of claims 6-10, 12-20 and 30 cannot be sustained.

According to the examiner, claims 6, 7, 9, 10, 12, 13, 16-20 and 30 are rejected on the basis of a combination of Reed and at least three other prior art references: Biles, Chang or Morita, and Kucera. Each of Biles, Chang or Morita, and Kucera is provided to furnish a missing feature otherwise not present in

Reed. The examiner specifically acknowledges (answer at 4) that Reed does not disclose: (1) categorizing the subject matter according to predetermined topics and the list includes age level information for individuals; (2) associating the keywords with at least one of the predetermined topics; (3) assigning a tag to the associated topic and keyword to form a tagged word; and (4) attaching a weighing factor to each generated tag.

The bulk of what is claimed by the appellants is missing from the primary reference Reed. Evidently, the only thing the examiner relies on from Reed is the storing of articles in a data base.

Biles is relied on by the examiner for the general feature of categorizing articles according to predetermined topics and the specific limitation of associating generated keywords with at least one of the predetermined topics (answer at 3). Our first order of business is to interpret the meaning of "keywords" in the context of the appellants' claimed invention. It does not have a self-supporting meaning independent of context. In light of the specification, it is clear that "keywords" are potential or probable text words in the articles under review (spec. at 9).

The appellants contend that Biles does not disclose or teach categorizing and associating keywords with at least one of the predetermined topics, "as opined by the examiner" (Br. at 8).

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The examiner cites to column 42, line 65, to column 43, line 2, as evidence that Biles discloses categorizing and associating keywords with predetermined topics (answer at 5). However, the referenced portion of Biles refers to descriptor phrases which describe the significance of a corresponding topology number representing a topic. In column 10, lines 30-32, Biles states: "The Descriptor field 11 is a sixty-character alphanumeric phrase which describes the topic." The descriptor phrases are not probable or anticipated text words in an article.

In response to the appellants' pointing out that the descriptor phrases merely describe a predetermined topic and thus are not the keywords in the context of the claimed invention, the examiner stated (answer at 6):

The Examiner respectfully disagrees because Biles teaches a data storage and retrieval system that facilitates collecting, cataloging, storing, searching, locating, querying, classifying, retrieving and displaying information regarding all aspects of human thought and endeavor. The system uses topology number to search the composite Catalog Data Base, which is self-indexing catalog that identifies the topics for which Subject Data Base records exist, to select the records related to the topics in question. Therefore, Biles must disclose the claimed categorizing and associating the keywords with one of the predetermined topics.

The examiner's position is without merit. It is based on mere speculation and generalities, rather than specifics in the cited

prior art reference. The examiner has failed to point to anything specific in Biles which discloses or teaches categorizing and associating keywords with predetermined topics. Even if Biles discloses such a feature, the examiner has failed to carry his initial burden in pointing out where and how the prior art meets the claimed feature. We decline to conduct examination in the first instance to fill in the gaps and to make up for deficiencies in the rejection. Thus, on this record, the examiner has failed to demonstrate that Biles discloses categorizing and associating keywords with predetermined topics.

Even if we, for argument purposes, assume that "keyword" can be met by the descriptor phrase in Biles, the examiner still has made reversible errors in connection with several other features of the claimed invention.

With respect to claim 6 which requires that the list of topics include age level information for individuals, the examiner concluded, without citing any supporting evidence, that "the list includes age level information for individuals would have been an obvious [design] choice to implement in order to meet the user need" (answer at 4). Without the examiner's having cited any evidence to support his view, we find the examiner's position to be mere speculation and without merit. The same is

true as to claim 12's focus information regarding handicapped individuals and claim 13's article topics selected from various specific groups.

The examiner stated (answer at 4): "Kucera teaches the step/means for assigning a tag to the keyword (cols. 1-2)." We note, however, that the claimed invention calls for assignment of a tag to the "associated topic and keyword." As is pointed out by the appellants (Br. at 11), Kucera generates a sequence of possible tags for each word in a sentence and then operates on strings of tags of adjacent words to determine the probable tags for each word, and each tag indicates a possible syntactic use of the word. In the claimed invention, however, the tags are assigned to a keyword and an associated topic for subsequent assignment of a weighing factor. Kucera does not disclose assigning a tag to any pair of associated topic and keyword, and Kucera provides no reasonable motivation for one with ordinary skill in the art to assign a tag to any pair of associated topic and keyword. Kucera's focus is on syntactic use of words, not on topics with which the words are associated. The examiner erroneously concluded that Kucera's tag is functionally equivalent to the claimed tag (answer at 6). Neither Kucera's nor appellant's tag simply provides a mark or identifies a word.

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It is improper to generalize claim features to some broader concept and then only attempt to find the broad concept in the prior art. It is the claimed invention which must be examined.

The examiner stated (answer at 4):

Chang and Morita teach the step/means for assigning a weight factor to a keyword (see Chang Col. 2, lines 22-25, and 30-45; col.7, line 40 to col. 10, line 30 and see Morita, col. 2, lines 39-43, col. 3, lines 9-16 and col. 6, lines 39-40). It would have been obvious to one skilled in the art to include the teaching of Chang and Morita in the Reed's system. This is because both Chang and Morita teach or suggest the use of weight factor assigned to each keyword by a user so that to enhance the user's power in controlling the searching process.

The appellants contend that Chang's weighing factors are relevance factors which concern the relative ranking of the retrieved articles rather than weighing factors which are attached to a keyword and associated topic for categorizing the subject matter of the articles (Br. at 14). The appellants are partially wrong but also partially right. In column 7, Chang lists five attributes which a user may control within the weighing or ranking process, one of which is Importance -- Relative weight of the term assigne[d] by the user. It can be said that a weighing factor is assigned to keywords. However, the claims call for attaching a weighing factor to each "tag" and a "tag" is assigned to a pair of associated topic and keyword.

Chang does not disclose or provide reasonable motivation to one with ordinary skill in the art to attach a weighing factor to any tag which is assigned to an associated topic "and" keyword. The same deficiency is exhibited by Morita, which assigns a weight value to keywords to determine the degree of relationship between keywords for assessing the relevance level of the document retrieved and not to any tag assigned to an associated topic "and" keyword.

For the foregoing reasons, the examiner has not demonstrated how the prior art would have reasonably suggested any of

- (1) associating keywords with at least one predetermined topic,
- (2) assigning a tag to the associated topic and keyword, and
- (3) attaching a weighing factor to each such tag.

Absent these features, the examiner has not shown how the prior art would have suggested providing a score indicating keywords present in the article in relation to "said weighing factor" and "said tag," or selecting those articles having the greatest such score. The references individually have not been shown to have anything substantial to do with paired topics and keywords or operations thereon. The references in combination also have not been shown to have anything substantial to do with paired topics and keywords or operations thereon.

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As for dependent claims 8, 14 and 15, they stand rejected over the same collection of references plus either Miyamoto or Hung. Miyamoto and Hung are relied on for the additional features recited in the dependent claims and do not make up for the deficiencies of the other references with respect to the independent claims.

Accordingly, the rejection of claims 6-10, 12-20, and 30 cannot be sustained.

Conclusion

The rejection of claims 6, 7, 9, 10, 12, 13, 16-20 and 30 under 35 U.S.C. § 103 as being unpatentable over Reed in view of either Chang or Morita, and Biles and Kucera is reversed.

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The rejection of claims 8 and 14 and 15 under 35 U.S.C.
§ 103 as being unpatentable over Reed in view of either Chang or
Morita, and Biles and Kucera, and further in view of either
Miyamoto or Hung is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
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